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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,528	09/24/2001	Hiroshi Sumiyama	325772026900	5299
25227	7590	02/27/2006		
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			EXAMINER QIN, YIXING	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,528

Applicant(s)

SUMIYAMA ET AL.

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to applicant's amendment received 10/27/05, all requested changes have been entered.

Response to Arguments

Applicant's arguments, filed 10/27/05 have been fully considered and are persuasive. The previous rejection of all the claims has been withdrawn. However, the Examiner will cite new art that he believes teaches/suggests the claimed invention – Japanese Patent Application Hei 10-105353. Furthermore, the Examiner is objecting to claim 4 and it's dependent claims 5 and 6. Please see more detail below

Allowable Subject Matter

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: The features claimed in claims 4-6 regarding the selection of a printer based upon printer attributes (e.g. could be paper size, color printing, speed, etc.) has been known in the printing environment (i.e. – Jackelen et al (U.S. Patent No. 6,865,354), McCormick et al (U.S. Patent No. 5,706,411), and Takemoto (U.S. Patent No. 6,624,906)). However, the combination of these references with the primary reference (Japanese Patent Application Hei 10-105353) would be inappropriate since the primary reference teaches

a different approach to handling the printing of leftover pages of a job which were not printed due to the lack of the correct paper size in a chosen printer.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motegi (Japanese Patent Application Hei 10-105353)

The Examiner would like to note that the primary reference relied upon is a machine translation of a Japanese publication and thus there are slight grammatical and word choice errors. However, the Examiner believe it is good enough to get ideas of the inventor across.

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1. Claims 1, 8, and 10

- Motegi discloses in P[0006] a description of his invention which includes a job including varying sized papers sent to a "print server" (i.e. **image processing apparatus**) and printed on one or more printers.
- Motegi does not go into great detail about the page size storage in a memory in the server. In P[0006] lines 1-3, Motegi discloses that there are printers with "two or more paper sizes...that is controlled by the print server." This suggests that the print server would have knowledge of the printer's size capabilities. It is also a well-known fact that print server or other computer equipment can gather information about print attributes such as size, color, speed, etc.
- Motegi discloses in P[0006] lines 4-6 that a file of the page data with, essentially, plural page sizes is "outputted to the printer server equipment" (i.e. sent to the print server). The print server would inherently have an obtaining unit, such as a network interface card, for receiving data over a network.
- Motegi discloses in P[0006] lines 6-7 that the printer server distributes this data to the printer equipment that has the ability to print every paper size in the data. Although it is not explicitly stated that there is a comparison, it would be obvious that some decision making, i.e. comparison, would take place in order to choose one printer over another. This would also suggest that the printer server selects the "best" printer because it can handle all the paper sizes in the print job.
- The transmitter can simply be can interface from the print server to the printer or to a network containing the printer and would be an inherent feature of the print server since it needs to send data.

2. Claim 2

- As mentioned above, the print server selects the printer that can print every paper size.

3. Claims 3, 9 and 11

- Motegi discloses in P[0006] lines 10-17 a situation in which a paper size cannot be printed out (i.e. that the other paper sizes or most paper sizes of a multiple size document have been printed at a selected printer), it would be printed with the previously selected printer.

II. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motegi (Japanese Patent Application Hei 10-105353), and in view of Shima (U.S. Patent No. 6,369,909).

4. Claim 7

- Motegi does not discuss the communication between printers in order to obtain paper sizes available in each printer. However, the secondary reference, Shima, discloses in the abstract that a printer can obtain performance attributes of other printers and relay it to a host. Fig. 13 and column 23, lines 58-67 and column 14, lines 1-13 discusses these attributes, one of which is paper size.
- Both references are in the art of networked printing and selection of appropriate printer(s) to print a print job. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include printers in the Motegi reference that were able to cross communicate. The motivation would be to reduce the amount of work on a print server if one printer were able to gather information about other printers on the network and relay the attribute information of all the printers to a print server without necessarily having the print server querying all the printers for attribute information.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUSAN L. HARRIS
SUSAN L. HARRIS
SUSAN L. HARRIS